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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,479	03/31/2004	Hiroshi Itoh	1232-5360	8559
27123 7590 03/21/2008 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
PINKNEY, DAWAYNE				
ART UNIT		PAPER NUMBER		
2873				
NOTIFICATION DATE		DELIVERY MODE		
03/21/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

Shopkins@Morganfinnegan.com

jmedina@Morganfinnegan.com

### Office Action Summary

**Application No.**

10/815,479

**Applicant(s)**

ITO, HIROSHI

**Examiner**

DAWAYNE A. PINKNEY

**Art Unit**

2873

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/21/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 12, 13, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, 13, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/2007 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 12, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger et al. (US 5, 912, 720).

Regarding **claim 1**, Berger discloses, an ophthalmologic image pickup system, comprising:

an image pickup device (Column 3, lines 41-44, Column 5, lines 13-25 and 10 and 14 of Fig. 1) having;

an output unit for adding an image pickup device information to an image data of eye fundus which is picked up, and outputting the image data to an image-processing device (Column 3, lines 41-44, Column 4, lines 7-10, Column 5, lines 34-40 and Fig. 1);

the image processing device (Column 3, lines 1-3, Column 3, lines 58-64, and Column 6, lines 44-47) having;

a determination unit for determining an image processing to be performed based on the image pickup device information added to the image data which is outputted from the output unit (Column 3, lines 41-44, Column 4, lines 7-10 and Fig. 1); and

an image processing unit for performing the image processing on the image data, to which the image pickup device information is added, in accordance with a determination result of the determination unit (Column 3, lines 1-3, Column 3, lines 58-64 and Column 6, lines 44-47).

Regarding **claim 12**, Berger discloses, an ophthalmologic image pickup system according to claim 1, wherein the image pickup device information includes information regarding an image pickup mode of one of a color image pickup mode, a Fluorescein fundus angiography mode, and an Indocyanine green angiography mode (Column 1, lines 57-61, Column 3, lines 46-51 and Column 6, lines 29-33).

Regarding **claim 15**, Berger discloses, an ophthalmologic image processing apparatus, comprising:

a determination unit for determining an image processing to be performed based on an image pickup device information added to an image data which is outputted from an output unit (Column 3, lines 41-44, Column 4, lines 7-10, and Fig. 1); and

an image processing unit for performing the image processing on the image data, to which the image pickup device information is added, in accordance with a determination result of the determination unit (Column 3, lines 1-3, Column 3, lines 58-64, Column 5, lines 34-36);

wherein the ophthalmologic image pickup system has an image pickup device that has the output unit for adding the image pickup device information to the image data of eye fundus which is picked up, and for outputting the image data to the image processing device (Column 3, lines 41-44, Column 4, lines 7-10, Column 5, lines 34-40, and Fig. 1).

Regarding **claim 17**, Berger discloses, an ophthalmologic image pickup device, comprising:

an output unit for adding an image pickup device information to an image data of eye fundus which is picked up, and for outputting the image data to an image processing apparatus (Column 3, lines 41-44, Column 4, lines 7-10, Column 5, lines 34-40, and Fig. 1);

the image processing device (Column 3, lines 1-3, Column 3, lines 58-64, and Column 6, lines 44-47) has;

a determination unit for determining an image processing to be performed based on the image pickup device information added to the image data which is outputted from the output unit (Column 3, lines 41-44, Column 4, lines 7-10, and Fig. 1); and

an image processing unit for performing the image processing on the image data, to which the image pickup device information is added, in accordance with a determination result of the determination unit (Column 3, lines 1-3, Column 3, lines 58-64, and Column 6, lines 44-47).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (US 5, 912, 720) as applied to claims 1, 10 and 15 above, further in view of The Admitted Prior Art.

Berger remains as applied to **claims 1, 10 and 15 above**.

Berger does not teach the image pickup device information includes information indicating whether or not at least one of processing for vertically reversing the image data and processing for horizontally reversing the image data should be performed by the image processing unit.

The Admitted Prior Art discloses, the image pickup device information includes information indicating whether or not at least one of processing for vertically reversing the image data and processing for horizontally reversing the image data should be performed by the image processing unit (Page 2, lines 1-5 in The Admitted Prior Art of the instant specification).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the image pickup device processing of The Admitted Prior Art with the device

of Berger because the image pickup device processing of The Admitted Prior Art is conventional.

Regarding **claim 3**, The Admitted Prior Art discloses, An ophthalmologic image pickup system according to claim 1, wherein the image pickup device information includes information indicating whether or not the image data should be synthesized with an electronic aperture mask by the image processing unit (Page 2, lines 5-8).

Regarding **claim 4**, Neither Berger nor The Admitted Prior Art disclose the determination unit determines the image processing to be performed in accordance with a processing table showing an image data processing method corresponding to the image pickup device information, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the image processing means to display the image data processing method to be performed on each of the images captured by the image pickup devices in some form (table, chart, listing, etc.) because this allows the examiner to see the image data processing method that is to be performed on the images captured by the image pickup devices.

Regarding **claim 5**, Berger discloses, an ophthalmologic image pickup system according to claim 1, wherein the image pickup device information includes a description of a kind of the image pickup device (which is deemed inherent).

Regarding **claim 13**, The Admitted Prior Art discloses, an ophthalmologic image pickup system according to claim 1, wherein the image processing unit performs at least one of conversion of the image data into a white-and-black image,  $\gamma$  characteristic adjustment thereof, and contrast processing thereof when information regarding an image pickup mode is one of a

Fluorescein fundus angiography mode and an Indocyanine green angiography mode (Page 3, lines 2-14).

### ***Response to Arguments***

6. Applicant's arguments filed 12/20/2007 have been fully considered but they are not persuasive.
7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the device information generated by the device information generation means is, e.g., "T0001", based on the determination by the device information determination means, the image processing device do not performs the horizontal reverse and vertical reverse, and it is unnecessary to synthesize the aperture mask. Also, the color image is converted into the white-and-black image, the gamma characteristic is adjusted, and the contrast processing is performed.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAWAYNE A. PINKNEY whose telephone number is (571)270-1305. The examiner can normally be reached on Monday-Thurs. 8 a.m.- 4:30 p.m..



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott J. Sugarman/  
Primary Examiner, Art Unit 2873

/DaWayne A Pinkney/  
Examiner, Art Unit 2873  
03/12/2008